

### **REMARKS**

Claims 1, 3-11, and 13-20 are pending in this application.

Applicants have amended claims 1 and 11. The changes to these claims made herein do not introduce any new matter.

#### **Rejections under 35 U.S.C. § 103**

Applicants respectfully request reconsideration of the rejection of claims 1, 3-7, 10, 11, 13-17, and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Nakami et al.* (“*Nakami ‘667*”) (US 2003/0151667 A1) in combination with *Nakami ‘127* (US 2003/0035127 A1). As will be explained in more detail below, the combination of *Nakami ‘667* in view of *Nakami ‘127* would not have rendered the subject matter defined in independent claims 1 and 11, as amended herein, obvious to one having ordinary skill in the art.

Applicants have amended independent apparatus claim 1 to clarify the features of the editing execution module. In particular, Applicants have amended claim 1 to specify that in the case of setting execution of the shooting information-based printing by the shooting information-based print setting module, the editing execution module executes editing under restrictions on editing to prohibit a predetermined editing item among available editing items of the image involved in the print job, and in the case of setting non-execution of the shooting information-based printing by the shooting information-based print setting module, the editing execution module executes with permission to all the available editing items of the image involved in the print job, which includes the predetermined editing item.

Applicants have amended independent method claim 11 to clarify the features of the executing of editing in response to an operator’s operation. In particular, in the case of setting execution of the shooting information-based printing, the executing includes executing editing under restrictions on editing to prohibit a predetermined editing item among available

editing items of the image involved in the print job, and in the case of setting non-execution of the shooting information-based printing, the executing includes executing with permission to all the available editing items of the image involved in the print job, which includes the predetermined editing item.

Support for the changes to claims 1 and 11 can be found in Applicants' specification (see, for example, the editing management routine shown in the flowchart of Figure 7 and the corresponding description of this figure at page 23, line 15, to page 25, line 1). As such, the changes to claims 1 and 11 do not introduce any new matter.

In formulating the obviousness rejection of claim 1, the Examiner asserts that the *Nakami* '127 reference discloses an editing execution module having the claimed features. With regard to the presently claimed subject matter, the *Nakami* '127 reference describes only that the setting values for each of the parameters are set automatically by selecting a correction mode (see Paragraph [0065]). Moreover, manual setting of desired parameter values is performed to change parameter values selected by the correction mode (see Paragraph [0067]). As such, the *Nakami* '127 reference does not disclose or suggest an "editing execution module" having the features specified in present claim 1, e.g., editing is executed under restrictions on editing to prohibit a predetermined editing item among available editing items of the image involved in the print job. In contrast with the presently claimed subject matter, in the *Nakami* '127 reference the parameter values can be changed even when the correction mode is selected.

Furthermore, with regard to the claimed shooting information-based print setting module, neither the *Nakami* '667 reference nor the *Nakami* '127 reference discloses or suggests setting either execution or non-execution of shooting information-based printing in the course of selecting a template used for printing. Thus, the *Nakami* '667 and the *Nakami*

‘127 references cannot reasonably be considered to disclose or suggest the shooting information-based print setting module specified in present claim 1.

In view of the foregoing, even if the *Nakami* ‘667 reference and the *Nakami* ‘127 reference were to be combined the manner proposed by the Examiner, the result of this combination would not have included each and every feature of the subject matter defined in present claim 1. Therefore, the combination of *Nakami* ‘667 in view of *Nakami* ‘127 would not have rendered the subject matter defined in present claim 1 obvious to one having ordinary skill in the art.

Independent claim 11 defines a print job creation method that includes method operations that correspond to the functionality of the print job creation apparatus defined in claim 1. As shown above, Applicants have amended claim 11 along the same lines that claim 1 has been amended. As such, the arguments set forth above regarding present claim 1 also apply to present claim 11.

Accordingly, for at least the foregoing reasons, independent claims 1 and 11, as amended herein, are patentable under 35 U.S.C. § 103(a) over the combination of the *Nakami* ‘667 and the *Nakami* ‘127 references. Claims 3-7 and 10, each of which ultimately depends from claim 1, and claims 13-17 and 20, each of which ultimately depends from claim 11, are likewise patentable under 35 U.S.C. § 103(a) over the combination of the *Nakami* ‘667 and the *Nakami* ‘127 references for at least the same reasons set forth above regarding the applicable independent claim.

#### Dependent Claims

Each of dependent claims 8, 9, 18, and 19 ultimately depends from either claim 1 or claim 11. In the Final Office Action, each of the above-listed dependent claims was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Nakami* ‘667 in view of *Nakami* ‘127, and further in view of *Hui et al.* (“*Hui*”) (US 6,237,010 B1). The *Hui*

reference does not cure the above-discussed deficiencies of the combination of the *Nakami* '667 and the *Nakami* '127 references relative to the subject matter defined in present claims 1 and 11. Accordingly, claims 8, 9, 18, and 19 are patentable under 35 U.S.C. § 103(a) over the combination of *Nakami* '667 in view of *Nakami* '127, and further in view of *Hui* for at least the reason that each of these claims depends from either claim 1 or claim 11.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1, 3-11, and 13-20, as amended herein, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. ITECP009).

Respectfully submitted,  
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